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PATENT, TRADEMARK, COPYRIGHT
AND UNFAIR COMPETITION LAW
AND RELATED LITIGATION

EDMUND P. WOOD 1923-1969
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DATE: November 15, 2004

RE: Serial No. 09/986,260; Filed:
November 8, 2001; For:
Surgical Clamp Devices and
Methods Especially Useful
in Cardiac Surgery; Applicants:
Warren P. Williamson IV et al.;
Conf. No. 5011

TO: Examiner Anh Tuan Tuong Nguyen
Group Art Unit 3763

FROM: Kevin G. Rooney

FAX NO.: 703-872-9306

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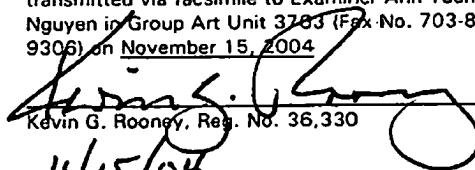
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Kevin G. Rooney, Reg. No. 36,330

11/15/04
Date

Applicants: Warren P. Williamson IV et al.
Serial No.: 09/986,260
Filed: November 8, 2001
Art Unit: 3763
Examiner: Anh Tuan Tuong Nguyen
Conf. No: 5011
Title: SURGICAL CLAMP DEVICES AND METHODS ESPECIALLY
USEFUL IN CARDIAC SURGERY
Atty. Ref.: IDX-02A

Cincinnati, Ohio 45202

November 15, 2004

RESPONSE

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

This responds to the Office Action mailed July 13, 2004. The Examiner indicates that claims 1-62 are pending, and that claims 11, 19, 30, 38, 50, 53-55 and 62 are withdrawn from consideration at this time. The Examiner further indicates on the Office Action cover sheet that claims 1-10, 12-29, 31-37,

39-49, 51, 52 and 56-61 are rejected. However, Applicants' counsel notes that independent claim 56, while indicated as being rejected on the cover page of the Office Action, is not mentioned in any rejection contained in the body of the Office Action. Therefore, the basis for the Examiner's rejection of claim 56 is not of record and, if the Examiner maintains such a rejection, explanation of the rejection should be given in the next Office Action, which should be made non-final.

The Rejection of Claims 1-9, 14-28, 32-37, 39, 42-49, and 52 Under 35 U.S.C. § 102(b)

Of these claims, claims 1, 20, 42 and 46 are independent. Each of these independent claims specifically recites an "internal core portion" adapted to be inserted "transversely into the vessel." Each of these independent claims further sets forth additional detailed structure in combination with the internal core portion which allows the clamping device to be clamped and sealed against the vessel of a patient during a surgical procedure once the core portion is inserted transversely into the vessel.

The Examiner relies on the Fogarty patent and states that Fogarty discloses "a clamping device that is capable of occluding a vessel during a surgical procedure comprising an internal core portion (V) having a distal end and surfaces adapted to be inserted transversely into a vessel." This statement by the Examiner is not understood and is not based on a rational interpretation of the Fogarty patent as compared to the relevant claim language. The so-called "core portion" (V) of Fogarty is, in fact, the vessel itself which is being clamped by the clamping pads 30

as clearly shown on the face of the Fogarty patent (Fig. 1). The claimed "internal core portion" cannot be properly interpreted to read on the vessel of a patient. Clearly, the claimed internal core portion is a part of the device which is actually inserted into the vessel of the patient. Moreover, it is improper for a device claim to set forth a body part of a human being as a positive claim limitation. Therefore, even if Applicants had intended for the "internal core portion" to read on a body part of the patient, this would not have been legally proper. Moreover, it is improper for the Examiner to interpret a claim in a manner which is legally impermissible. As the Examiner's rejection is clearly not based on any fair and reasonable interpretation of the claims in view of the Fogarty reference, the rejection under 35 U.S.C. § 102(b) should be withdrawn.

The Rejections Under 35 U.S.C. § 103(a)

Applicants' counsel further notes the rejection of various dependent claims as allegedly being unpatentable over Fogarty in view of either Hung et al. (U.S. Patent No. 6,413,228) or Palti et al. (U.S. Patent No. 5,624,454).

Applicants' counsel respectfully submits that the secondary references to Hung et al. and Palti et al. fail to cure the basic deficiencies of Fogarty as discussed above. Namely, these secondary references fail to disclose the use of an internal core portion which is adapted to be inserted transversely into a vessel and then clamped externally and sealed in accordance with the claimed structure and methods. For at

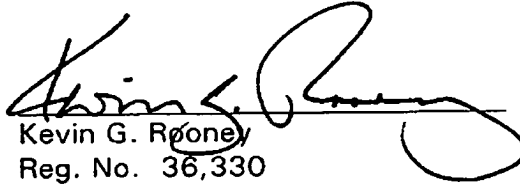
least these reasons, the rejections under 35 U.S.C. § 103(a) should also be withdrawn.

If the Examiner believes any matter requires further discussion, the Examiner is respectfully invited to telephone the undersigned attorney so that the matter may be promptly resolved.

Applicants do not believe that any fees are due in connection with this response other than the extension fee. However, if such petition is due or any other fees are necessary, the Commissioner may consider this to be a request for such and charge any necessary fees to deposit account 23-3000.

Respectfully submitted,

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